



02-14-06

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Serial Number: 10/605,873

Our File No.: 10008.3855

**CERTIFICATE OF EXPRESS MAIL**

I HEREBY CERTIFY that the following correspondence: Appellant's Reply Brief; and a Return Postcard for confirmation of receipt, is being deposited with the United States Postal Service as Express Mail No. EV 720779598 US, addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia, 22313-1450 on this 13<sup>th</sup> day of February, 2006.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

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Arlette J. Breakstone / Paralegal

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|----------------------|---|--|
| In re application of | : | February 13, 2006                                    |
| Serial No.           | : | ANDERSON, Michael R.                                 |
| Filed                | : | 10/605,873   |
| For                  | : | November 3, 2003                                     |
| Examiner             | : | <b>DISPENSING CAPSULE FOR A LIQUID<br/>CONTAINER</b> |
| Art Unit             | : | BUI, Luan Kim  |
| Our File No.         | : | 3728   |
|                      | : | 10008.3855   |



**APPELLANT'S REPLY BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to Rules of Practice §41.41, Appellant submits this Reply Brief to the Examiner's Answer. A Notice of Appeal was filed on September 26, 2005. An Appeal Brief was filed on November 16, 2005. The Examiner's Answer was filed on December 22, 2005.

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## REPLY TO ARGUMENTS MADE IN EXAMINER'S ANSWER

### First Ground of Rejection

The Examiner's rejection of claims 1, 2 and 4 under 35 U.S.C. 102(b) as being anticipated by English (1,774,258)(hereinafter "English '258) is erroneous. An anticipation rejection under 35 U.S.C. 102(b) requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 31 U.S.P.Q.2d 1671 (Fed. Cir. 1994). For anticipation, there should be no difference between the claimed invention and the reference disclosure as viewed by a person of ordinary skill in the art. Scripps Clinic & Fes. Found. V. Genentech, Inc., 927 F.2d 1565, 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991). The English reference does not contain each and every element of appellant's claimed invention and there is a definite difference between the claimed invention and the English reference.

The argument presented in the Examiner's Answer that "English '258 discloses the partition 4 connected to the flange 5 which is considered equivalent to the capsule first member body as claimed" is structurally incorrect. In Figures 1, 2 and 3 the partition is shown with the flange 5 inside of the open end of section 2 of the capsule and outside the open end of section 3 of the capsule. Column 2, line 64 of the English'258 patent explains that the partition and the two capsules are "held in position frictionally" or through the use of cement. Thus, the structure of the capsule in the English'258 patent is only held together when section 2 and section 3 and the flange 5 are used on conjunction. Without the force provided by section 2, the partition and section 3 would not remain sealed. Likewise, without the force provided by section 3, the partition and section 2 would not remain sealed.

The appellant's invention in claim 1 is structurally different. Only a first and second body member comprise the capsule. According to the language in claim 1 the "first and second members ... are sealed". Hence, unlike the English '258 patent, the appellant's invention does not use other securing or force inducing objects (like the partition 5 in English '258) to achieve a sealed and stable fit. Therefore, the English '258 reference cited by the Examiner does not contain every limitation to the invention described in claims 1, 2 and 4 of the Appellant's application. The Examiner's rejection is incorrect and should be reversed.

#### Second Ground of Rejection

The Examiner's argument that "it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made in view of English '258 to modify the cutting edge of Bowes et al. so the cutting edge comprises a first prong and a second prong" is erroneous.

The Examiner's argument that "the edge disposed between the first and second prongs of English '258 is considered equivalent to the cutting edge as claimed" in the application is incorrect. The English '258 reference discloses in Column 3, line 5-15 that the pointed projections or cutters 12 alone "penetrate" the partition 4 and the sections of the capsule must then be turned so that the cutters 12 may cut the partition away from the flange 5. Thus, the edge between the cutters 12 is not equivalent to the cutting edge as claimed because if it were, a user would simply need to push the cutters 12 further through the partition. The edge between the cutters 12 seemingly is dull and stops further cutting of the partition, thus requiring the turning motion.

Further, the cutting cylinder 27 in the Bowes et al. patent is structurally very different and operates mechanically different from the cutting edge in both English'258 and the claimed invention. The Bowes et al. patent is operated by a force which pushes the cutting cylinder 27 directly downward without any turning or twisting. In addition, the cutting edge 27 in the Bowes et al. patent operates by first piercing the flat bottom 16 at the one lowest point. It then proceeds to cut around the edge of the flat bottom 16 because of its cylindrical shape.

Claim 1 of appellant's invention requires a "first prong" and a "second prong" disposed along the peripheral edge of the second body member and having a cutter edge disposed between said first prong and said second prong. There is no teaching in English'258 or Bowes, et al. to suggest the combination to one of ordinary skill in the art to provide the cutting edge between the prongs or cutters. Also, it is appellant's position that even if a person of ordinary skill in the art combined Bowes, et al. '369 somehow with the English '258 device, one would not arrive at appellant's claimed invention. Further, the mechanics of operating the Bowes et. al patent are different than that of English'258, making it highly unlikely that a person of ordinary skill in the art would see an obvious combination of the two patents. Since claims 2, 3 and 4 depend from claim 1, it is appellant's position that claims 1 through 4 would not be obvious to one of ordinary skill in the art in view of the references cited by the Examiner and the Examiner's rejection must be incorrect and reversed.

### Third Ground of Rejection

The Examiner's argument that it would have been obvious to one having ordinary skill in the art to provide apertures in the peripheral lip 21 of Bowes et. al in view of Rizzardi

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(5,038,951) is erroneous. There must be something in the prior art as a whole to suggest the desirability and, thus, the obviousness of making the combination. C.R. Bard Inc. v. M3 Sys. Inc., 157 F.3d 1340, 48 U.S.P.Q.2d 1225 (Fed. Cir. 1998). The mere fact that it is possible to find two isolated disclosures that might be combined in such a way as to produce a new compound does not necessarily render such production obvious unless the art contains something to suggest the proposed combinations. In re Grabiak, 769 F.2d 729, 226 U.S.P.Q. 870 (Fed. Cir. 1985). The absence of a suggestion to combine is dispositive in an obviousness determination. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 42 U.S.P.Q.2d 1378 (Fed. Cir. 1997).

One of ordinary skill in the art would not be motivated to combine such bridges 15 as shown in Figures 1, 2 and 3 of Rizzardi '951 to the peripheral flange 21 in Bowes, et al. '369 since the disclosed structures and functions are so completely different. Bowes, et al. '369 shows a peripheral flange 21 that is used merely to fit over the mouth of a container and stabilize the Bowes et. al '369 device. The Rizzardi '951 device shows bridges 15 which are merely temporary connections between the two cylindrical sections 11 and 12. The bridges 15 then are broken when the one cylindrical section 12 is pushed into the other cylindrical section 11. The object for using the bridges 15 is that they will break easily not be used again. This is the opposite of the object of the peripheral flange 21 in Bowes, et al. '369 which provides sustained stability.

There must be a reason apparent at the time the invention was made to a person of ordinary skill in the art for applying the teaching at hand, or the use of the teaching as evidence of

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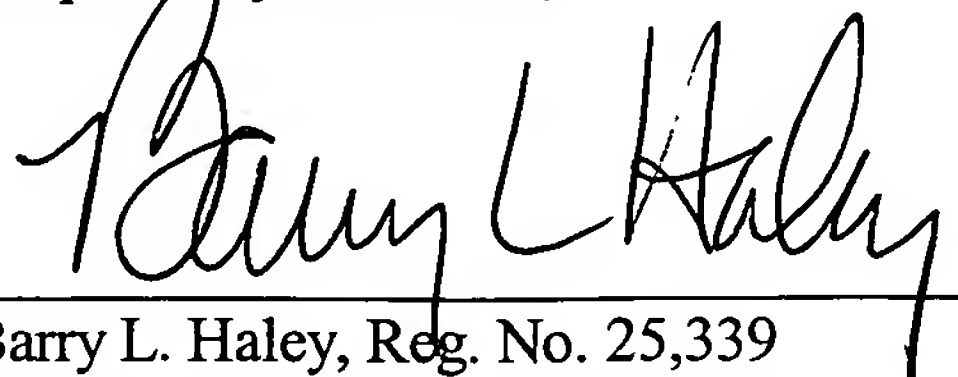
obviousness entails the prohibited use of hindsight. In re Nomiya, Kohisha, and Matsumura, 509 F.2d 566, 184 U.S.P.Q. 607 (C.C.P.A. 1975). It is inaccurate and pure hindsight for the Examiner to state that a person of ordinary skill in the art at the time of the invention would use two objects unrelated in structure and purpose in combination. The Examiner's claim that a person would likely combine the two references to reduce the material and the cost of manufacture is wrong and does not comply with the reasoning presented above. The Examiner's argument is thus erroneous and must be reversed.

#### Fourth Ground of Rejection

Appellant respectfully acknowledges the Examiner's withdrawal of the rejection of claim 6, however, the appellant argues that claim 6 does not need to be changed into independent form because claims 1 through 5 are allowable as demonstrated in the arguments made in the Appeal Brief and the Reply Brief explained above.

If there are any additional charges, including extension of time, please bill our Deposit Account No. 13-1130.

Respectfully submitted,



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